(5)

No. 95-728

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.
Petitioner,

v.

HILTON DAVIS CHEMICAL CO.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* SEAGATE TECHNOLOGY, INC. IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI, IN WHICH THE FOLLOWING CORPORATIONS JOIN:

Amdahl Corporation
Cirrus Logic, Inc.
Coherent, Inc.
Conner Peripherals Inc.
Eastman Medical Products, Inc.
Giro Sport Design, Inc.
Intel Corporation
Read-Rite Corporation
Scitex Digital Video Inc.
Storage Technology Corporation
Western Digital Corporation

CARRIE L. WALTHOUR
(Counsel of Record)
KARL A. LIMBACH
NEIL A. SMITH
KATHLEEN A. FROST
LIMBACH & LIMBACH
2001 Ferry Building
San Francisco, CA 94111
(415) 433-4150

BOWNE OF SAN FRANCISCO, INC. • 343 SANSOME ST. • S.F., CA 94104 • (415) 362-2300

5 pp

No. 95-728

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.
Petitioner,

v.

HILTON DAVIS CHEMICAL CO.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* SEAGATE TECHNOLOGY, INC. IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI, IN WHICH THE FOLLOWING CORPORATIONS JOIN:

Amdahl Corporation
Cirrus Logic, Inc.
Coherent, Inc.
Conner Peripherals Inc.
Eastman Medical Products, Inc.
Giro Sport Design, Inc.
Intel Corporation
Read-Rite Corporation
Scitex Digital Video Inc.
Storage Technology Corporation
Western Digital Corporation

STATEMENT OF AMICI

The parties listed above as *amici curiae* file this brief in support of the petition for writ of certiorari in the case of *Warner-Jenkinson Company, Inc. v. Hilton Davis Chemical*

Co.. Written consent to the filing of this brief has been obtained from the petitioner and the respondent and is being filed herewith.

Amici urge the Court to grant certiorari in this case because of the increased uncertainties over the past ten years in the application of the judicial doctrine of equivalents. These increased uncertainties (particularly the role of the jury in the application of this doctrine) have become an unreasonable deterrent to the making of business decisions involving patents.

The purpose of the claims of every patent is to give notice of the metes and bounds of the invention protected by the patent. *Zenith Laboratories, Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418 (Fed. Cir. 1994), *cert. denied,* 115 S.Ct. 500. However, as detailed in Petitioner's Brief, the law governing the application of the doctrine of equivalents makes the scope of protection afforded by a patent claim extremely uncertain. Brief for Petitioner at 15-21. The United States Court of Appeals for the Federal Circuit in *Hilton-Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995) has heightened this uncertainty by holding that patent infringement under the doctrine of equivalents may be asserted in *all* patent infringement cases, while providing little clarification as to how that doctrine is to be applied by judges or juries.

Moreover, the role of juries has increased dramatically in recent years. *Director of Administrative Office of U.S. Court Annual Reports 1972, 1992 and 1993* (giving percentage of patent trials decided by juries in 1972, 1980, 1992, and 1993 as approximately 10%, 17%, 51% and 50%, respectively). This increased jury participation has been accompanied by the uncertainty of how a jury will decide complex high technology issues and how it will react to emotional evidence which is technically irrelevant to the scientific questions at issue.

The majority of the technologies of Silicon Valley businesses, such as those of *amici,* are new, dynamically changing, and result in the design and sale of products often having life cycles that are very short. For this reason, businesses wishing to pursue new products must often make decisions regard significant initial investments and bring new products swiftly to market. Notice and understanding of the scope of the claims of relevant patents, including how they might be applied to an accused product under the doctrine of equivalents, is essential information for many of the business decisions that must be made by these *amici* and other Silicon Valley and United States manufacturers.

For example, manufacturers such as *amici* are often faced with the dilemma of having to decide whether to make substantial investments in the design, development, production, and marketing of a new product when another party holds a relevant patent which is not literally infringed by the proposed product. However, the uncertainty, created by the doctrine of equivalents, of whether a jury might still find the differences between the new product and the patent claims "insubstantial" may well deter businesses from making such investments and introducing new products into the marketplace.

Furthermore, the cost of patent litigation and the size of patent jury awards has dramatically increased over the last decade. Patent infringement defendants are often exposed to damage awards which may exceed the value of the business involved. For these reasons, it is all the more critical that businesses such as these *amici* be able to make these crucial decisions with some degree of predictability and comfort. However, given the uncertainty that the doctrine of equivalents creates regarding the scope of patent claims, businesses, innovators, and their counsel cannot rely on the language of patent claims to evaluate whether new products or designs infringe existing patent claims. Faced with the

uncertain scope of patent claims and the *uncertain* costs and potential damages to which their activities may expose them, persons or businesses wishing to introduce new products will simply be discouraged from doing so, rather than face the risk of the consequence of an adverse jury decision.

For the foregoing reasons, amici urge this Court to grant certiorari in this case so as to relieve businesses and innovators of the burdens imposed upon them by the uncertainties of the doctrine of equivalents as reflected in the *Hilton-Davis* case and its predecessors.

Respectfully submitted,

CARRIE L. WALTHOUR
(Counsel of Record)
KARL A. LIMBACH
NEIL A. SMITH
KATHLEEN A. FROST

LIMBACH & LIMBACH
2001 Ferry Building
San Francisco, CA 94111
(415) 433-4150